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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,800	03/08/2007	Douglas H. Robinson	13355/10901	4462
23838 7590 02/26/2010 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER NAVARRO, ALBERT MARK				
ART UNIT 1645		PAPER NUMBER		
MAIL DATE 02/26/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/593,800

**Applicant(s)**

ROBINSON, DOUGLAS H.

**Examiner**

Mark Navarro

**Art Unit**

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 7-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date 9/21/06

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-6, in the reply filed on December 15, 2009 is acknowledged. The traversal is on the ground(s) that at least some of the claims should be rejoined because they share the same or corresponding special technical feature, for example claims 7-12 should be rejoined because these claims share the same or corresponding special technical feature of the culture of morphotes. This is not found persuasive because as set forth in the International Preliminary Examination Report, and also as evidenced by the 102 rejections below, the special technical feature of the instantly claimed invention is disclosed by the prior art, accordingly unity of invention is defeated and restriction as set forth previously is deemed appropriate.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-6 are directed to cultures comprising morphotes which have the same characteristics and utility as morphotes found naturally and therefore does not constitute as patentable subject matter.

In the absence of the hand of man, naturally occurring products are considered non-statutory subject matter. Diamond v. Chakrabarty, 206 USPQ 193 (1980). Mere purity of naturally occurring product does not necessarily impart patentability. Ex parte Siddiqui 156 USPQ 426 (1966). However when purity results in new utility, patentability is considered. Merck Co. V. Chase Chemical Co. 273 F. Supp 68 (1967). See also American Wood v. Fiber Disintegrating Co., 90 US 566 (1974); American Fruit Growers v. Brogdex Co. 283 US 1 (1931); Funk Brothers Seed Co. V. Kalo Inoculant Co. 33 US 127 (1948). Filing of evidence of a new utility imparted by the increased purity of the claimed invention and amendment to the claims to recite the essential purity of the claimed products is suggested to obviate this rejection. For example, "An isolated culture of morphotes ..."

#### ***Claim Rejections - 35 USC § 112***

2. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Claims 1-6 recite a culture of morphotes derived from mammalian tissues. Applicants define morphotes as pleomorphic organisms which exhibit morphologic and genetic characteristics of both prokaryotic and eukaryotic cells. (Specification, page 1). Applicants further describe a method for isolating morphotes by collecting lymphoma specimens and placing them in a culture medium under anaerobic conditions, followed

by aerobic conditions, and followed yet again by anaerobic conditions. (Specification, Example 1).

The specification and claims do not indicate what distinguishing attributes are shared by the members of the genus. Thus, the scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, "culture of morphotes/isolated by the described method of Example 1" alone is insufficient to describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus.

Adequate written description requires more than a mere statement that it is part of the invention and a reference to a potential method of isolating it. The protein itself is required. See *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Lts.*, 18 USPQ2d 1016.

*Vas-Cath Inc. V. Mahurkar*, 19 USPQ2d 111, clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed."

Applicant is reminded that Vas-Cath make clear that the written description provision of 35 USC 112 is severable from its enablement provision.

Applicants are directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, 1 "Written Description" Requirement, the guidelines can be found at the following link on the USPTO Internet in "Patents Guidance" Specifically, Example 17, which is analogous to the recitation of a claimed product (morphotes) identified via a method of production (description provided in Example 1).

<http://www.uspto.gov/web/patents/guides.htm>

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite in the use of the phrase "derived." Since it is unclear if the morphotes are undergoing any kind of chemical modification as implied by the recitation of "derived." Since it is unclear how the morphotes are to be derived as referred to in the claims, there is no way for the person of skill in the art to ascribe a discrete and identifiable definition to said phrase.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wainwright et al.

The claims are directed to a culture of morphotes derived from mammalian tissues.

Wainwright et al (Medical Hypotheses Vol. 60, No. 2, pp 290-292, Feb 2003/IDS REF 3) disclose of isolating highly pleomorphic bacterium having a number of morphological characteristics in common with many historical cancer germs. (See page 290). Wainwright et al further disclose that the culture turned pink-purple and "branched forms" grew, and that under low magnification superficially appeared fungal. (See page 290).

Given that Applicants have defined the term "morphotes" as pleomorphic organisms which exhibit morphologic and genetic characteristics of both prokaryotic and eukaryotic cells; and that Wainwright has isolated a culture of pleomorphic bacterium organisms (prokaryotic) from mammalian tissue, which superficially appeared fungal (eukaryotic), the disclosure of Wainwright et al is deemed to anticipate the instantly filed claims.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson.

The claims are directed to a culture of morphotes derived from mammalian tissues.

Robinson et al (IDS REF 6; 2001) disclose of isolating prokaryotes from a sterile cell culture system in which sterile human eukaryotes were subjected to an oxygen environment of alternating anaerobiosis and aerobiosis. Robinson disclose that all prokaryotes isolated were classified as Gram-positive, and were often highly pleomorphic in culture. (See page 1). Robinson et al further report that immunoblot studies indicated that various prokaryotes so isolated expressed both human genes/proteins. (See again page 1).

Given that Applicants have defined the term "morphotes" as pleomorphic organisms which exhibit morphologic and genetic characteristics of both prokaryotic and eukaryotic cells; and that Robinson isolated a culture of pleomorphic bacterium organisms (prokaryotic) from mammalian tissue, which also expressed both human genes/proteins (eukaryotic), the disclosure of Robinson is deemed to anticipate the instantly filed claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (571) 272-0861.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Mondesi can be reached on (571) 272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Navarro/  
Primary Examiner, Art Unit 1645  
February 24, 2010